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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/628,472 | 07/31/2000 | Paul K. Wolber | 10003511-1 | 5543 |

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EXAMINER

FORMAN, BETTY J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| | 1634 |

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|------------------------|---------------------|--|
| Advisory Action | Application No. | Applicant(s) | |
| | 09/628,472 | WOLBER ET AL. | |
| | Examiner | Art Unit | |
| | BJ Forman | 1634 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: ____.

3. Applicant's reply has overcome the following rejection(s): ____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: ____.

Claim(s) objected to: ____.

Claim(s) rejected: 1-15 and 21-23.

Claim(s) withdrawn from consideration: ____.

8. The drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). ____.

10. Other: ____.



BJ Forman
Primary Examiner
Art Unit: 1634

Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because:
Applicant's arguments are not found persuasive to overcome the outstanding rejections.

Applicant argues that Dattagupta does not disclose a "mixture" of nucleic acids as claimed because the term mixture means a heterogenous composition e.g. two or more different nucleic acids. The argument has been considered but is not persuasive to overcome the rejection. The claims are rejected under 35 U.S.C. 103 over Dattagupta and Conrad. Conrad clearly teaches the mixture of nucleic acids i.e. "probe cocktails". Hence, the claimed mixture is taught in the cited prior art. Furthermore, while Dattagupta does not specifically teach a mixture of nucleic acids, the primer extension reaction would produce a mixture due to incomplete extension products always present in such reactions. The rejection over Dattagupta and Conrad is not dependent upon incomplete extension because Conrad clearly teaches this element and provide motivation for providing their probe cocktail as discussed in the Office Action.

Applicant argues that the Office has impermissably used hindsight reasoning to combine the teachings of Dattagupta and Conrad. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues the Office has impermissably combined the references because Dattagupta only teaches a single type of template and would not be motivated to modify the beads to each display two or more different templates because one would not be able to use those beads to detect a single analyte. The argument has been considered but is not found persuasive because the claims are drawn to immobilized nucleic acids. Applicant appears to be asserting that the claims are drawn to a plurality of different nucleic acids immobilized on a single substrate. However, the claims are not so limited. Hence, Applicant's assertion that the modification suggested in the Office Action would not function as Dattagupta desires is not relevant to the instant claims.

Applicant argues that the cited reference do not teach every element of the claims because they do not teach "a single substrate" having immobilized probes of differing sequence. The argument has been considered but is not found persuasive because as stated above, the claims do not require the differing probes be immobilized to the same i.e. a single substrate. Hence, the argument is not commensurate in scope with the claims.

Regarding Claims 10-15, Applicant asserts that one of ordinary skill would not have been motivated to combine the teachings of Cantor with Conrad because Cantor's method is based on keeping synthesized nucleic acids separate for each other. The argument has been considered but is not found persuasive. The claims are drawn to a method of making a mixture of molecules according to the method of Claim 1 and using the mixture as primers to produce a population of target molecules. Applicant appears to be asserting that one of skill in the art would not have been motivated to immobilize the probe cocktail of Conrad. However, Applicant has not pointed to any support for the assertion in the teachings of Conrad. Furthermore, the claim, as written, encompasses immobilized probe mixtures.


BJ FORMAN, PH.D.
PRIMARY EXAMINER